

REMARKS

The instant application as acknowledged by the Examiner at the top of page 2 of the 5/1/07 Office Action is a duly filed application under 37 C.F.R. 1.114. According to Manual of Patent Examining Procedure, “[A]n applicant may have recourse to filing a continuation in order to introduce into the case a new set of claims and to establish a right to further examination by the primary examiner.” Manual of Patent Examining Procedure § 201.07 (1994). See also Manual of Patent Examining Procedure § 201.11 (1994).

This was the reason the applicants filed the instant application—to introduce a new set of claims and to present arguments as to why the rejection as set forth in the office action of October 18, 2006 did not apply to the amended claims.

The Examiner in an Office Action dated January 24, 2007 maintained the final rejection on the ground that the proposed amendment after final raised new issues requiring further consideration and/or search. The applicants then filed this RCE.

In the Office Action dated 5/1/07 to which this paper is directed, the Examiner states that the finality of the previous Office Action is withdrawn pursuant to 37 C.F.R. 1.114. Applicants’ amendment has been entered. The Office Action is a final rejection. The Manual of Patent Examining Procedure is very clear (MPEP §706.07 (b)) as to when a final rejection is proper and when not proper in a first action. Thus the Manual reads, “However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry

because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised.”

The instant application was filed to obtain consideration of amended claims. The amended claims were not considered because they raised new issues. A first office action final is therefore improper and should be withdrawn.

The Examiner’s statement at page 9 of the office action that “Applicants’ amendment necessitated the new ground(s) of rejection presented in the office action. Accordingly, THIS ACTION IS MADE FINAL” is not understood. The rejection of the claims as unpatentable over Ishida is an old ground of rejection and has been present going back to the earlier application.

Withdrawal of the final rejection is respectfully requested.

The Examiner has rejected claims 1-11 and 13 (all of the claims under consideration) under 35 U.S.C. 102(b) as being anticipated by Ishida.

The interference cancellation system and method of Ishida are entirely devoted to earth stations in a satellite communications system that has means for cancelling received return signal due to the local transmission signal so as to result in the desired signal transmitted from a second earth station via the satellite (emphasis ours). There is no teaching or suggestion of such an interference cancellation for the satellite payload.

Claims 1 (and claims 2-9 that depend from claim 1), 10 and 11 of the application contain specific limitations that the system and method are related to the interference cancellation on a satellite payload.

In order to serve as an anticipatory reference, Ishida would have to contain each and every element of applicants' claims.

The interference cancellation system and method as taught by Ishida is directed to a system "capable of bidirectional satellite communication between earth stations via a satellite. Each earth station ..." (abstract see also Fig. 2 underlining ours). The satellite communications system is provided with means for canceling received return signals due to the local transmission signal transmitted from a second earth station via the satellite.

There is no teaching or suggestion in Ishida of such an interference cancellation system for the satellite payload. The claims also recite that two antenna are provided in applicant's system, a first antenna which is used to receive communication signals from a first source, for example a mobile phone to a second antenna which is used to receive an interference reference signal from a second source, for example, a base tower. (see paragraph 27 for example and figures 2 and 3) Paragraph 27 refers specifically to the satellite payload system and notes that it has "a first antenna 52 for receiving a first communication signal 54. The satellite payload circuit 61 also has a second antenna 66 which transmits transmit signal 65 to a ground based terminal 42.



The restriction of applicant's invention to a satellite payload and the incorporation of two antenna and their specified application none of which is found in Ishida series to make a 35 USC 102 (b) rejection based on Ishida not maintainable.

All of the independent claims contain specific limitations. The defendant claims merely add preferred features. Again, the rejection under 35USC102 (b) is therefore improper as the reference, Ishida does not teach or suggest aforesaid two limitations.

The first action final on these grounds is also improper since as noted the final rejection dated 1/24/07 states that applicants' amendment of 12/16/2006 was not entered as it raised new issues. Withdrawal of the final rejection entry of the amendment and imposition of a final rejection does not avoid the existing situation of a first office action final where the attempted amendment was not entered as raising new issues.

Withdrawal of the rejection and allowance of the claims is respectfully requested.

Respectfully Submitted,
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